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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	244/068	3722

29129 7590 10/03/2003

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,392

Applicant(s)

KATZ ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23, 36, 39, 40, 42-50, 68-71 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 36, 39, 40, 42-50, 68-71 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8-11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on 8/22/03, wherein:
claims 21-23, 36, 39, 40, 42-50, 68-71, and 75 are pending;
claims 1-20, 24-35, 37, 38, 41, 51-67, 72-74, and 76-197 have been canceled; and
claims 70, 71, and 75 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21, 22, 36, 39, 40, 42-46, 50, 68-71, and 75 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,295,064 (Malec et al.).

Regarding **claim 21**, Malec et al. discloses a method for providing at least one offer of an item, the item including at least one of a good and a service, utilizing an electronic communication device (514) enabling communication between an offeror and a user of the electronic communication device comprising the steps of: establishing communication via the electronic communication device (514) between the offeror and the user to enable the user to at least initiate a primary transaction there between (see column 5, lines 7-22); obtaining primary transaction data related to the primary transaction, the primary transaction data including at least data representing an identity of the user (see column 24, lines 40-56) and data representing a

geographic position of the user (see column 1, lines 58-66); utilizing the identity of the user to obtain at least a further data element related to the user (see column 24, lines 40-56); utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer for the item in real time (see column 5, line 16, “immediately”) with the primary transaction, and offering the item to the user (see column 24, lines 40-56 and column 1, lines 58-66); **[claim 22]** the electronic communication device is a wireless device (see Figure 4, 504); **[claim 36]** the offer comprises a coupon (see column 24, line 50-52, “coupon”); **[claim 39]** contacting the user via the electronic communications device (514) to offer the at least one item to the user (see column 5, lines 7-22); **[claim 40]** the determination of the at least one offer is subject to negative decision criteria (inherent since the system utilizes user profile and location information, it is inherently negating possible offers); **[claim 42]** the offer is made orally to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 43]** the offer is made visually to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 44]** obtaining primary transaction data includes obtaining a geographic identifier representing the geographic position of the user (see column 1, lines 58-66); **[claim 45]** obtaining data from a carrier associated with the electronic communications device (see column 8, lines 41-65); **[claim 46]** obtaining data from a network associated with the electronic communications device (see column 8, lines 41-65); **[claim 50]** offering at least one item related to an entity that is geographically local to the user (inherent).

Regarding **claim 68**, Malec et al. discloses a method for providing at least one offer as set forth in detail for claim 21. **Claims 69-75** are rejected for reasons similar to claims 22, 36, 39, 40, 42-46 as described above in detail.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view U.S. Patent No. 6,397,057 (Malackowski et al.).

Regarding **claims 23 and 47**, Malec et al. fails to expressly disclose a wireless phone communication device that utilizes ANI for determining a geographic identifier.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing ANI data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with wireless ANI data as taught by Malackowski et al., because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

6. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view of Official Notice.

Regarding **claims 48 and 49**, Malec et al. fails to expressly disclose a user or an operator manually entering geographic identifying information.

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The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an operator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

Response to Arguments

7. Applicant's arguments filed 6/2/03 have been fully considered but they are not fully persuasive.

Objections to the drawings are withdrawn in view of Applicant's submission of proposed drawing changes.

Objections to the specification are withdrawn in view of Applicant's amendments to the specification.

On page 23, Applicant's arguments related to art-based rejections are moot in view of the new grounds of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

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Vela et al. and O'Hagan are cited of interest for disclosing system that generates direct marketing via mobile communications device to a user based at least partially on geographic location.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

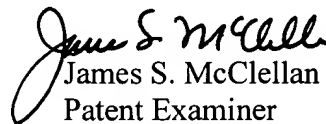
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner
A.U. 3627

jsm
October 1, 2003